

Remarks

In the fourth and fifth paragraphs of the Official Action, Examiner objected to the claims because Examiner believes the term "requesting at least one second set of
5 update information responsive to at least a size of the first set of update information" is vague and the structural connection between this step and the updating of the computer system is not clear. This objection is respectfully traversed, however, Applicants are amending
10 the claims to allow for faster allowance.

First, for Examiner's education, there are two ways to claim a "size". One is to explicitly state it in the manner in which the claim now reads. However, another perfectly acceptable way of claiming a size is to
15 implicitly claim it in the manner of the claim before the amendment. In both cases, the size is stated and is part of the claim. Thus, the explicit size language has not changed the scope of the claim. It has been changed simply because Examiner appears to be unfamiliar with the implicit
20 claiming method used, and Applicants desire to rapidly bring the case to conclusion. The scope of the claims has not changed and the change has not been made for patentability purposes.

The claims have been similarly simplified with respect to changing the language, "at least one set" to "a set" because two or more sets can, together, be a set. Thus, no change in claim scope has been intended with respect to
5 that amendment, nor has the amendment been made for patentability purposes. Claims 3 and 10 are similarly amended without change in scope. The amendment has been made merely to eliminate all possible issues from consideration and to ensure the fast allowance of the
10 claim.

Examiner has been requesting that the second set have a structural connection to the updating the computer system language of the claim. Although Applicants do not believe that a "structural connection" to all elements of the
15 claims is required as long as the claim performs the function set out in the preamble, we see no harm in complying with Examiners request, and have done so in a way that preserves the scope of the claim. For Examiner's education, the phrase, "one selected from A and B" means "A
20 or B". The 'A' and 'B' in the amended claim both contain the first set, and therefore, the claim is not further limited in any manner by the amendment, nor has the amendment been made for patentability purposes - only to avoid further delay.

Similarly, something that is responsive to something is also responsive to at least that thing, and thus the amendment removing the "at least" language after the words "responsive to" is intended to have no effect on claim
5 scope.

Claim 15 has been amended in a manner similar to that of claims 1 and 8, including the language regarding the first set of update information having a size, in spite of the fact that the claim had immediately stated that the
10 size was identified, again for no other reason than to end the discussion over the issue. Like all of the amendments being made, this amendment has not been made for patentability reasons nor changed the scope of the claims.

Applicants are amending the claims as described above
15 in spite of the fact that there is no requirement to do so because it can be done without change in claim scope. With regard to claims 5, 12 and 19, an amendment is similarly not required. Applicants would amend these claims in the same spirit of cooperation, but any amendment would leave
20 open the possibility for a future opponent to argue that the scope of the claims had changed, and therefore, the doctrine of equivalents protection was lost, and therefore, applicants respectfully traverse this rejection as well,

but will not change the claim language. The term
"occasion" has a dictionary definition consistent with the
specification and so Examiner's objection has no basis in
law. The terms "on a first occasion" or "on a second
5 occasion" may be thought of as including "at a first time"
and "at a second time". If Examiner would like to cite a
rule that requires in the claims only the exact words used
in the specification, a rule that Applicants do not believe
exists, Applicants will reconsider their position, but
10 merely conclusively stating that a word that has an
accepted dictionary definition is unclear or that the exact
term used was not used in the specification is not going to
suffice as proper grounds for a rejection and Applicants
traverse it on the basis described above.

15 Examiner has objected to the claims dependent on
claims 1, 5, 8, 12, 15 and 19 based on the objection to
those claims. As noted, those claims are clear, and
therefore their dependent claims are also clear.

The claim terms are clear, and therefore Examiner is
20 requested to withdraw the objection.

In the twelfth paragraph of the official action,
Examiner raises the issue that the method claims do not
state the actor performing the actions. These are method

claims and do not require an actor. With regard to the computer program product claims, there is no actor: the claims are directed towards computer program products that are configured to cause a computer to act in the manner
5 claimed, but do not require any actor at all. The claims cover the existence of the claimed computer readable program code devices, even if those computer readable program code devices never do in fact cause a computer to performed the functions claimed.

10 In the sixth through ninth and eleventh paragraphs of the Official Action, Examiner rejected claims 1, 8 and 15 and their dependent claims under 35 U.S.C. 102(b) as being unpatentable over U.S. Patent 5,386,553 issued to Fujita ("Fujita"). This rejection is respectfully traversed.

15 As amended, claim 1 recites, "requesting a second set of update information responsive to at least the size of the first set of update information". Claims 2-4 depend from claim 1 and contain all of its limitations.

Claim 8 recites, "computer readable program code
20 devices configured to cause a computer to request a second set of update information responsive to at least the size of the first set of update information". Claims 9-11 depend from claim 8 and contain all of its limitations.

Claim 15 recites, "a requester having an input coupled to the holding area manager size output for receiving the size, the requester for requesting at an output at least one second set of update information responsive to the size
5 received at the requester input". Claims 16-18 depend from claim 15 and contain all of its limitations.

These claimed features request a second set of update information responsive to a size of a first set of update information.

10 These claimed features are not shown by Fujita. Fujita column 4, line 68 - column 5, line 11 address changing the size recorded for a file that is being updated. It does not teach or suggest requesting a second set of update information responsive to a size of a first
15 set of update information as claimed. Therefore, claims 1, 8 and 15 are patentably distinguishable over Fujita. Because claims 2-4 depend from claim 1, claim 9-11 depend from claim 8, and claims 16-18 depend from claim 15, claims 1-4, 8-11 and 15-18 are patentably distinguishable over
20 Fujita.

Examiner states in paragraph 12 of the Official Action that Fujita does address updating files, and updating information, but what Fujita does not do is request a

second set of update information based on the size of a first set of update information as claimed. Examiner needs to point to something in Fujita that addresses this claim limitation or to allow the claims.

5 In the fifth, ninth and tenth paragraphs of the Official Action, Examiner rejected claims 5, 12 and 19 and their dependent claims under 35 U.S.C. 102(b) as being unpatentable over Fujita. This rejection is respectfully traversed.

10 Claim 5 recites, "requesting on a first occasion a first set of update information for a first set of information responsive to a list comprising at least one identifier of the first set of information and at least one identifier of a second set of information; receiving the
15 first set of update information responsive to the request; modifying the first set of information responsive to the first set of update information received; requesting on a second occasion, following the first occasion, a second set of update information for the first set of information
20 before any update information for the second set of information is requested following the first occasion".

 Claim 12 recites, "computer readable program code devices configured to cause a computer to request on a

first occasion a first set of update information for a first set of information responsive to a list comprising at least one identifier of the first set of information and at least one identifier of a second set of information;

5 computer readable program code devices configured to cause a computer to receive the first set of update information responsive to the request; computer readable program code devices configured to cause a computer to modify the first set of information responsive to the first set of update

10 information received; computer readable program code devices configured to cause a computer to request on a second occasion, following the first occasion, a second set of update information for the first set of information before any update information for the second set of

15 information is requested following the first occasion."

Claim 19 recites, "a requester having an input for receiving a list comprising at least one identifier of a first set of information and at least one identifier of a second set of information, the requester for: providing at

20 an output during a first occasion a request for a first set of update information for the first set of information responsive to the list; and providing at the output on a second occasion, following the first occasion, a request for a second set of update information for the first set of

information before any update information for the second set of information is requested; a holding area manager having an input for receiving the first set of update information responsive to the request; and an
5 installer/deleter having an input coupled to the holding area manager for receiving the first set of update information, the installer deleter for providing at least one command at an output to modify the first set of information responsive to the first set of update
10 information received at the installer/deleter input".

These claimed features request a first set of update information for a first set of information from a list of identifiers of a first and second sets of information. The first set of information is modified responsive to the
15 update information received responsive to the request. Later, a second set of update information is requested for the first set of information before any update information for the second set of information is requested after the first set of information was requested.

20 Fujita column 2, lines 24-30, column 2 line 53 to column 3, line 31, column 5, lines 12-35 and column 7, lines 19-25 do not teach or suggest the claimed features. Fujita addresses updating files on disk in accordance with

an "opcode" that can modify a file and thereby adjust the size of the file. Examiner does not assert that Fujita teaches or suggests the claimed features of "requesting on a first occasion a first set of update information for a first set of information responsive to a list comprising at least one identifier of the first set of information and at least one identifier of a second set of information" or "requesting on a second occasion, following the first occasion, a second set of update information for the first set of information before any update information for the second set of information is requested following the first occasion" as claimed, and Applicants are also unaware of any such teaching in Fujita. Examiner is respectfully reminded that Claims 5, 12 and 19 are independent claims. If Examiner believes that the limitations of these claims are shown by Fujita, Examiner is requested to point out where each limitation is shown, not just reference large portions of Fujita having limited (if any) relevance to the claimed features.

Therefore, claims 5, 12 and 19 are patentably distinguishable over Fujita. Because claims 6 and 7 depend from claim 5, claims 13 and 14 depend from claim 12, and claims 20 and 21 depend from claim 19, claims 5-7, 12-14 and 19-21 are patentably distinguishable over Fujita.

Claims 1-21 are in condition for allowance. Although
the claims have been amended, their scope has not changed,
and so no further search should be required. Nevertheless,
Examiner has requested an additional search and Applicants
5 have no objection to one additional search being made.
Favorable action is solicited.

Respectfully Submitted,
April 29, 2004

10

By: Charles E. Gottlieb

15

Charles Gottlieb
Registration No. 38,164
Innovation Partners
540 University Ave.
Suite 300
Palo Alto, CA 94301
(650) 328-0100